

REMARKS

In an Office Action dated November 6, 2007, the Examiner objected to the amendment filed October 10, 2007 under 35 U.S.C. §132(a); rejected Claims 6 and 7 under 35 U.S.C. §112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; requested clarification regarding canceled Claim 8; rejected Claims 1, 2, 4, 5, 18, and 19 under 35 U.S.C. §103(a) as being unpatentable over WO 02/10255 ("Herzig et al."); rejected Claims 1, 2, 4, 5, 18, and 19 under 35 U.S.C. §103(a) as being unpatentable over Raleigh et al.; and rejected Claims 1, 2, 4, 5, 18, and 19 under 35 U.S.C. §102(b) as being anticipated by Plueddemann. These rejections are respectfully traversed. Applicant has carefully reviewed the Examiner's objections, rejections, and comments as found in the Office Action dated November 6, 2007 and provides the following remarks regarding the Office Action. Claims 1, 2, 4 – 7, and 18 – 19 are pending in this application.

New Matter – 35 USC §132(a)

The Examiner has rejected the amendment filed October 10, 2007 under 35 U.S.C. §132(a) because it introduces new matter into the disclosure. This rejection is respectfully traversed. Nevertheless, Applicant has canceled the amended disclosure presented in the October 10, 2007 response. Therefore, it is believed that this rejection is overcome.

Claim Rejection – 35 USC §112, Second Paragraph

The Examiner has Claims 6 – 7 under 35 USC §112, Second Paragraph, as being indefinite for failing to particularly point out and claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed. Nevertheless, Applicant has amended Claims 6 – 7 to clarify the proportions of the combinations of amines. Claim 8 has been canceled in a previous amendment.

Claim Rejection – 35 USC §103(a)

The Examiner rejected Claims 1, 2, 4, 5, and 18 – 19 under 35 U.S.C. §103(a) as being unpatentable over WO 02/10255, herein Herzig et al (US Pat. No. 6,835,419). This rejection is respectfully traversed. Applicant respectfully submits that the Herzig et al. neither forms the basis of nor establishes a *prima facie* case of obviousness. For a *prima facie* case of obviousness to be established, the following factual inquiries as enunciated in *Graham* must be determined: (A)

determining the scope and contents of the prior art; (B) ascertaining the differences between the prior art and the claims at issue; (C) determining the level of skill in the pertinent art; and (D) evaluating any evidence of secondary considerations. Further, in *KSR*, a number of rationales for supporting a conclusion of obviousness consistent with the “functional approach” in *Graham* were laid out. Additionally, it is key that the Examiner articulate their reason why the claimed invention would have been obvious. (MPEP 2143)

As the Examiner has noted, Herzig et al. teaches a reaction product between an epoxy siloxane and a diamine that is subsequently protonated, thus the reaction product is an intermediate product. Herzig et al. does teach stopping the reaction before it becomes a gel and then protonating the intermediate to create a stable alpha omega material, not a branched system as described and claimed in the present application. Further, Herzig et al. uses a solvent based reaction to avoid creating a gel (Col. 8, Ln. 65 – Col. 9, Ln. 9). Also, the Herzig et al. reference dissolves the polymer in materials such as diethylene glycol and dibutyl ether, followed by protonating the intermediate with acetic acid. The present application does not involve any of these steps or elements. Applicant has amended Claims 1 and conduit 18 to include these limitations. Support for these negative limitations may be found in the fact that they are not considered nor taught in the present application.

Thus, Applicant respectfully submits that Herzig et al. does not form the basis of a *prima facie* case of obviousness of independent Claims 1 and 18. Therefore, it is believed that Claims 1 and 18 are allowable under 35 U.S.C. §103(a). Claims 2, 4, 5, and 19, depend from and include all the limitations of previously amended Claims 1 and 18, respectively, thus they are also believed to be allowable under 35 U.S.C. §103(a).

Regarding Raleigh et al., it describes many known silicone polymers and reacts them with possibly polycarbonates. In addition, the Raleigh et al. reference claims thermoplastics, but the present invention does not disclose nor claim thermoplastic type materials.

For the reasons stated above, Raleigh et al. reference in light of previously amended independent Claims 1 and 18, Applicant respectfully submits that the Raleigh et al. reference does not form the basis of a *prima facie* case of obviousness of independent Claims 1 and 18. Therefore, it is believed that Claims 1 and 18 are allowable under 35 U.S.C. §103(a). Claims 2, 4, 5, and 19

depend from and include all the limitations of previously amended Claims 1 and 18, respectively, thus they are also believed to be allowable under 35 U.S.C. §103(a).

Claim Rejection – 35 USC § 102(b)

The Examiner has rejected Claims 1, 2, 4, 5, and conduit 18-19 under 35 U.S.C. §102(b) as being anticipated by Pluedemann. For a *prima facie* case of anticipation to be established, the Examiner must show that, each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP §2131

Applicant respectfully submits that Plueddeman does not teach each and every claim element of the Applicant's application as amended herein, and thus does not establish a *prima facie* case of anticipation. Therefore, it is believed that these rejections are overcome and amended Claims 1, 37, and 40 are allowable under 35 U.S.C. §102(b).

Applicant's application discloses a stoichiometric excess of amine relative to an epoxy functional silicone that is then reacted with at least one epoxy resin to produce the benefits noted therein. As noted in Pluedemann, the excess amine is stripped away prior to the solution being used with an epoxy resin. The polyol prepolymer chain extender of the present application uses a stoichiometric excess of amine relative to the at least one branched epoxy functional silicone containing a phenyl group to further react with the isocyanate prepolymer when making the final silicone modified polyurea. (See Pg. 9, Lns. 28-30) The Applicant has amended independent Claims 1 and 18 to clarify that the excess is a stoichiometric excess to clarify this distinction. Thus, Plueddeman does not teach each and every element of Applicant's independent Claims 1 and 18.

For the reasons stated above with respect to Plueddeman in light of amended independent Claims 1 and 18, Applicant respectfully submits that Plueddeman does not form the basis of a *prima facie* case of anticipation of independent Claims 1 and 18. Thus, it is believed that the Examiner's rejections regarding Claims 1 and 18 have been overcome and are allowable under 35 U.S.C. §102(b). Claims 2, 4, 5, and 19 depend from and include all the limitations of amended Claims 1 and 18, respectively, thus they are also believed to be allowable under 35 U.S.C. §102(b).

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance. A fee of \$525.00 for a three-month extension is believed to be due. However, if any other fee is due, please charge the deficiency to our Deposit Account No. 50-2816, under Order No. 009608.0113PTUS from which the undersigned is authorized to draw.

Application No. 10/648,934
Amendment dated May 6, 2008
Reply to Office Action dated November 6, 2007

Docket No.: 009608.0113PTUS

Respectfully submitted,

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